

## REMARKS

Claims 17-37 remain in this application. Claims 17, 20, and 31 have been amended. No claims have been added or cancelled. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

### 35 U.S.C. §103(a) Rejection – Felcman in view of Douglas

The Examiner has rejected claims 17-37 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,830,394 issued to Felcman, et al. (hereinafter referred to as “Felcman”) in view of U.S. Patent No. 5,156,049 issued to Douglas (hereinafter “Douglas”). The Applicants respectfully submit that: (a) Felcman and Douglas should not be combined; and (b) even if Felcman and Douglas are combined, which does not even seem appropriate, the combination still does not teach or suggest all of the limitations of the independent claims.

#### (a) Felcman and Douglas Should Not Be Combined

Felcman and Douglas are from non-analogous arts. Felcman pertains generally to computer systems and more specifically to a keyboard having a track ball mechanism and a scroll mechanism (see e.g., the Title and Background of the Invention). In contrast, Douglas pertains to a manual input system for automotive test equipment (see e.g., the Title). Track ball and scroll mechanisms of computer systems and automotive test equipment are non-analogous arts.

As discussed in the MPEP 2141.01(a), to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. *“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s*

*endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.”* In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The problem addressed in Douglas would not logically have commended itself to an inventor's attention when he/she was considering the problem addressed in Felcman. The Examiner has not provided sufficient reason why a person skilled in the art of computer systems would look to the field of automotive test equipment. Further an inventor could not possibly be aware of every teaching in every art. In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979).

Secondly, there is no suggestion or motivation to combine Felcman and Douglas. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. There is no such suggestion or motivation.

An invention is not obvious where the Examiner fails to provide a suggestion even if the prior art “could” have been combined. The modification is not obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Accordingly, Felcman and Douglas should not be combined.

**(b) Any Combination of Felcman and Douglas Does Not Teach or Suggest All Claim Limitations**

Even if Felcman and Douglas are combined, which does not even seem appropriate for the reasons discussed above, the combination still does not teach or suggest the limitations of the independent claims.

Claim 17 recites an apparatus comprising “*a keyboard having a space bar and keys; a horizontal wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard to receive user input, wherein the wheel includes ridges; a tracking device positioned below the space bar to receive user input to direct a cursor displayed on a display, wherein the tracking device is closer to the space bar than the wheel; a right mouse button, wherein the right mouse button is positioned to the right of the wheel; a left mouse button, wherein the left mouse button is positioned to the left of the wheel*”. **No combination of Felcman and Douglas teaches or reasonably suggests the claimed apparatus including the claimed horizontal wheel positioned below the space bar to rotate horizontally relative to a top surface of the keyboard to receive user input.**

In the present Office Action, the Examiner has relied upon the trackball 12 and the discussion at column 4, lines 25-30 as disclosing this claim limitation. However, Applicants respectfully submit that: **(1) Felcman’s trackball is not a horizontal wheel; and (2) that Felcman’s trackball does not rotate horizontally relative to a top surface of the keyboard.** Firstly, a trackball is not a horizontal wheel. Secondly, Felcman’s trackball does not rotate horizontally relative to a top surface of the keyboard. As is known, if you rotate a trackball the top surface rotates into the plane of the keyboard.

Accordingly, claim 17 is believed to be allowable. Claims 18-19 depend from claim 17 and are believed to be allowable therefor, as well as for the recitations set forth in each of these claims.

In dependent claims 20 and 31, and their respective dependent claims, are believed to be allowable for similar reasons.

### **Conclusion**

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

### **Request For Telephone Interview**

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

### **Request For An Extension Of Time**

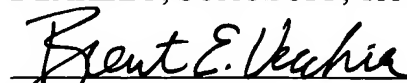
The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

### **Charge Our Deposit Account**

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 12/12/05

  
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